

**REMARKS/ARGUMENTS**

The Applicant respectfully requests further examination and consideration in view of the amendments above and the arguments set forth fully below. Claims 1-4, 6-10, 12, 13, 15-21, 23, 27-  
5 30, 34-36, 40, 41, and 43-51 are pending in this application. Claims 1-4, 7-16, 19, 27, 30, 34-35,  
40-41, 43-49, and 50-51 stand rejected under 35 U.S.C. 102(b). Claims 6, 17-18, 20-23, 28-29,  
and 36 stand rejected under 35 U.S.C. 103(a). By the above amendments, claims 1, 19, 20, 28, 34,  
46, and 48-51 are amended. Accordingly, claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40,  
41, and 43-51 are currently pending in this application.

10

**I. CLAIM REJECTIONS UNDER 35 U.S.C §102(b)**

Within the Office Action, claims 1-4, 7-16, 19, 27, 30, 34-35, 40-41, 43-49, and 50-51 are rejected under § 102(b) as being unpatentable over the article titled “recommend-it.com” (hereinafter “recommend-it”). The Applicant respectfully traverses this rejection.

15 In brief, the present claims are directed to a method of marketing that allows for personalized e-mail referrals including serial numbers and URL links to a website having an offer to transact for a marketable entity.

Recommend-it teaches a service whereby a first user can recommend a website to a second user. The recommendation comes in the form of an email sent by the recommend-it service to the  
20 second user. The email includes the name of the first user, the URL and brief description of the website recommended by the first user, and an optional personal message from the first user. To initiate the recommendation, the first user completes a form provided by the recommend-it service. The form is accessed by clicking a related button included on the recommended website. The first user provides their name and email address, the email address of the second user, and the optional personal

annotation to the second user.

The independent claim 1 is directed to a method of marketing comprising the steps of: a.) offering a reward to a first party in exchange for a recommendation of a marketable entity, the recommendation comprising a forwarding of a first e-mail message to a second party, the first e-mail message comprising a personalized referral for the marketable entity and a first set of data, the first set of data comprising a first serial number and a first URL link to a first Web site having an offer to transact an exchange for the marketable entity; b.) correlating the first set of data in the first e-mail message to data within a database, the data within the database comprising data relating to the reward offered to the first party; c.) updating the database with an e-mail address of a second party provided by the first party; d.) forwarding the first e-mail message to the e-mail address of the second party, wherein the marketable entity is selected from a group consisting of goods and services; and e.) providing the reward to the first party if the second party transacts the exchange for the marketable entity.

Recommend-it does not teach “offering a reward to a first party in exchange for a recommendation of a marketable entity”, where the recommendation includes “a first URL link to a first web site having an offer to transact an exchange for the marketable entity,” as claimed. Recommend-it teaches a recommendation for a website (recommend-it, page 2, left frame above line marked “line 1”). As such, for comparison sake, the recommended website of recommend-it is most analogous to the claimed recommended marketable entity. However, an offer to transact an exchange for the recommended website (as the claimed limitation is directed to an offer to transact for the recommended marketable entity) is nonsensical. Clearly, recommend-it does not teach an offer to transact an exchange for the recommended website. As such, recommend-it does not teach a recommendation of a marketable entity as claimed. The Examiner contends that recommend-it teaches a marketable entity in that “different categories of websites available offering different brands or goods.” However,

recommend-it does not teach that the recommendation is directed to any of the different brands or goods included in the recommended web site. Recommend-it teaches only a recommendation of the website itself. So again, recommend-it does not teach a recommendation of a marketable entity as claimed.

5        Further, there is no hint, teaching, or suggestion that the recommendation service of recommend-it includes any offer to transact, as claimed. The Examiner cites page 2 of recommend-it and states that the first user of recommend-it will send an e-mail to a friend or colleague detailing the site and would include a short description identifying the website, a link to the website and a personal annotation. However, there is no mention of an offer to transact. Further, the Examiner cites page 1 of  
10      recommend-it and states that different categories of websites are available that offer different brands or goods. However, there is no teaching within recommend-it that supports this conclusion. The recommend-it service is specifically directed to recommending a website, not any specific good or service that might be offered at the recommended website. As such, recommend-it does not teach a recommendation that includes an offer to transact, as claimed.

15       Within the Advisory Action, the Examiner states that the word “transact” merely means an activity involving two parties and in recommend-it, the first user recommends to “WebDeck software” as being the marketable entity, and the website and the second user transact or perform an activity such as logging on to the website to view the content of the site and the software recommended. By the above amendments to the claims, it is clarified that the present claims are directed to transacting an  
20      exchange for the marketable entity. Even if recommend-it teach a transaction as cited by the Examiner, the cited transaction does not teach an exchange for the marketable entity as claimed.

Still further, there is no hint, teaching, or suggestion that the recommendation service of recommend-it includes offering a reward for the recommendation, as claimed. The Examiner contends that the promotional newsletter offered by recommend-it is the same as the claimed reward. However,

element (a) of claim 1 includes “offering a reward to a first party in exchange for a recommendation of a marketable entity.” Recommend-it does not teach that the promotional newsletter is in exchange for recommending the website. The form on page 2 of recommend-it includes an option for the first user to receive the promotional newsletter. Although this option is presented on the same form that the first  
5 user fills out to recommend the website, the promotional newsletter is not an actual reward for making the recommendation because the promotional newsletter can be received regardless of whether the first user makes the recommendation. Specifically, recommend-it teaches on page 1, lines 10-12 that the promotional newsletter is available for free and that the newsletter can be obtained independent of the recommendation, as indicated by the “Sign up Today!” link on page 1, lines 11-12. Accordingly,  
10 recommend-it does not teach offering a reward in exchange for a recommendation.

Within the Advisory Action, the Examiner states that the newsletter is in exchange for recommending the website. In particular, the Examiner states that “as seen on page 2 (of recommend-it) is after the first user recommends the second user that it allows the first user the ability to select the free newsletter.” The Applicant disagrees with this conclusion. Page 2 of recommend-it shows a form.  
15 On the form, a particular web site is recommended by clicking the “Recommend-It!!” button (box 4). However, the recommendation is only provided if the “email recipient” field is completed. The form also includes a selection box (box 6) for choosing to receive the newsletter. There is no hint, teaching, or suggestion within recommend-it that the email recipient field is required to be filled out in order to receive the newsletter. In other words, the email recipient field (box 4) can be left blank, and the  
20 newsletter option (box 6) is selected, thereby receiving the newsletter without recommending the website. As such, recommending the website and receiving the newsletter are mutually exclusive.

Similarly, independent claims 46 and 50 are allowable over recommend-it for at least the same reasons as described above in regard to claim 1. Claims 2-4, 7-16, 19, 27, 30, 34-35, 40-41, 43-45 depend from independent claim 1. Claims 47-49 depend from the independent claim 46. Claim 51

depends from the independent claim 50. As described above, the independent claims 1, 46, and 50 are allowable over recommend-it. As such, each of the claims 2-4, 7-16, 19, 27, 30, 34-35, 40-41, 43-45, 47-49, and 51 are also allowable as being dependent upon an allowable base claim. For at least these reasons, Applicant respectfully submits that claims 1-4, 7-16, 19, 27, 30, 34-35, 40-41, 43-49, 50-51 are allowable.

## II. CLAIM REJECTIONS UNDER 35 U.S.C §103(a)

Within the Office Action, claims 6, 17-18, 20-23, 28-29, and 36 are rejected under § 103(a) as being obvious over recommend-it. In regard to claims 6, 17-18, and 20, Official Notice is taken that it is old and well known in the computer related field to have a token in the form of an icon that is visible in the message in order to represent a function, object, or program, and that it would have been obvious to a person of ordinary skill in the art to have included a token in the form of a first icon visible in the message in order to make file navigation and manipulation easier. In regard to claims 21-23, 28-29, and 36, Official Notice is taken that it is old and well known in the business related arts to credit an account because such a modification would provide an easy and efficient way to reward a customer, and that it would have been obvious to a person of ordinary skill in the art to have included crediting an account within a database and recording the reward credited in order to obtain the above mentioned advantage. The Applicant respectfully traverses the USPTO's Official Notice as to claims 6, 17-18, 20-23, 28-29, and 36. Applicant demands for evidence, including standard references and prior art references, upon which the USPTO rely to support the taking of said Official Notices. Applicant respectfully requests that the data be stated as specifically as possible, pursuant to MPEP §2144.03.

Claims 6, 17-18, 20-23, 28-29, and 36 are each dependent on the independent claim 1. As described above, the independent claim 1 is allowable over recommend-it. As such, each of the dependent claims 6, 17-18, 20-23, 28-29, and 36 are also allowable as being dependent upon an

PATENT  
Attorney Docket No.: DERN-00101

allowable base claim. For at least these reasons, the dependent claims 6, 17-18, 20-23, 28-29, and 36 are allowable.

### CONCLUSION

5        In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes that a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact the undersigned at (408) 530-9700.

Respectfully submitted,

10      HAVERSTOCK & OWENS LLP

Dated: 9-28-06

By: Thomas B. Haverstock

Thomas B. Haverstock

Reg. No. 32,571

15      Attorneys for Applicant

CERTIFICATE OF MAILING (37 CFR 1.8(e))  
I hereby certify that this paper (along with any related to an  
application or case) is being deposited with the U.S.  
Postal Service on the date above indicated with sufficient  
postage, in an envelope addressed to the:  
U.S. Patent and Trademark Office, Washington, DC,  
20593-1450.

HAVERSTOCK & OWENS LLP  
9/28/06 By: R. P. H.